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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/274,281	03/22/1999	JAY S. WALKER	WD2-99-006	8188

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EXAMINER

RIMELL, SAMUEL G

ART UNIT PAPER NUMBER

2166

DATE MAILED: 04/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/274,281

Applicant(s)

WALKER ET AL.

Examiner

Sam Rimell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-30 is/are allowed.
- 6) ☒ Claim(s) 1-12, 31-40, 44-51, 54 and 57-60 is/are rejected.
- 7) ☒ Claim(s) 41-43, 52, 53, 55 and 56 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

SAM RIMELL  
Primarily EXAMINED  
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Preliminary Note: Examiner notes that the Information Disclosure Statements provided in the present application are missing a number of cited documents. Examiner has provided copies of all Form 1449s cited thus far, with the missing documents indicated by no examiner signature next to the document citation. Applicant is required to provide the missing documents in response to this office action. If applicant chooses to point to previously filed patent applications as containing these documents, then applicant must correlate the documents to the specific patent applications where they are located.

Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrases "the second subsidy amount" and "the first subsidy amount" lack antecedent basis.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 38 is rejected under 35 U.S.C. 101 because the claimed invention is non-statutory.

Claim 38 depends from claim 31, which requires the offering of a subsidy to a customer for the purchase of a product. The subsidy creates a second price, which is less than the total price offered before the subsidy. However, claim 38 calls for the step of charging the customer the total price despite the presence of the subsidy, which would have the potential to be misleading to a consumer. Since it is a violation of Federal (and many state) laws to engage in misleading actions in the course of marketing a product, the subject of claim 38 is held to be non-statutory by reason that it violates public policy.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4, 7, 12, 31, 32, 39, 44, 45, 46, 47, 48, 49, 50, 54, 57, 59 and 60 are rejected under 35 U.S.C. 102(e) as being anticipated by Laor ('069).

Laor claims priority to its original filing date of September 1998. Although Applicant makes a sequence of claims to priority of applications dating back to September 4 of 1996, there is no evidence that the presently claimed subject matter was ever disclosed in any previous application to which applicant claims priority. Accordingly, applicant's effective filing date is considered to be the filing date of the present application and Laor is considered effective as a prior art reference under 35 USC 102(e).

Claim 1: Laor discloses the following method steps:

--Receiving an indication of at least one item a customer is to purchase from a first vendor (Customer contacts server A and receives electronic coupons at client (110), the coupons

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being good for purchase at a first vendor represented by server B or second vendor represented by server C);

--transmitting an indication of an offer for subsidy from the second vendor before an actual purchase (Customer is sent electronic cookies from server A which enable subsidies for purchase at the first vendor located at server B or second vendor located at server C);

receiving an indication that the customer accepts the offer (customer contacts the first vendor at server B and initiates an order);

providing an amount of funds to the first vendor (Customer pays the first vendor located at server B);

facilitating a transaction between the customer and second vendor (Customer contacts second vendor at server C and uses the electronic cookies to facilitate transactions with the second vendor).

Claim 2: The electronic cookies embedded in the client computer (110) create hyperlinks to all of the vendor websites (col. 5, line 36 of Lau).

Claim 3: When the customer contacts the second vendor at server C, any documents or hyperlinks transmitted from server C constitute a "form for receiving information";

Claim 4: The action of the customer in selecting a vendor to do business with is the step of determining a service provider.

Claim 7: The action of the customer selecting the second vendor is the step of determining.

Claim 12: The customer can receive cookies representing electronic coupons from a plurality of vendors, and engage in electronic commerce with a plurality of vendors.

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Claim 31: Laor discloses the following method steps:

--Transmitting an indication of at least one item that a customer is to purchase (Customer contacts server A and is transmitted electronic coupons from server A).

--Receiving an indication of offer for subsidy (Customer is displayed electronic coupons at client 110);

--Providing the offer for subsidy before the item is purchase (Customer is sent an electronic cookie to enable usage of the electronic coupons at other sites);

--Receiving from the customer an acceptance of the offer (Customer contacts server B with server B detecting presence of inserted cookie);

--Transmitting indication of acceptance of the offer (Customer initiates purchase of item using electronic coupon enabled by inserted cookie);

--Charging a customer a second price less than the total price (Customer is charged for purchase which is discounted by the electronic coupon).

Claim 32: The offer is displayed to the user in the form of an electronic coupon on the user's display.

Claim 39: Purchasing additional items using subsidies provided by the electronic coupons is well within the scope of the disclosure to Laor.

Claim 44: When the user makes the purchase at server B, the cookie representing the electronic coupon enables a price reduction, thus creating a second price less than the total price.

Claim 45: The second price is a predetermined amount less than the total price.

Claim 46: Any price reduction from the total price would inherently by a price reduction by a certain percentage.

Claim 47: The electronic coupon facilitates a transaction with a vendor at server B, but also with any other vendor, such as vendors at server A or server C.

Claims 48-50: The customer is offered an electronic coupon book which provides a plurality of subsidies to the customer simultaneously.

Claim 54: The customer uses the electronic coupon book to select from one of a plurality of subsidized offers.

Claim 57: An electronic coupon is an indication of a subsidy amount, and an indication that a consumer must perform a transaction to use the subsidy amount.

Claim 59: The second price is the difference between the total price and the subsidy amount provided by the electronic coupon.

Claim 60: If the second price is less than the total price, than the second price would inherently be any price, including zero, as long as it was less than the total price.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 6, 8-11, 33-37, 40, 51 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laor ('069).

Claim 5: Examiner takes Official Notice that making a purchase from a vendor that involves canceling a previous service agreement is very well known in the art, particularly where the purchase is Internet service or basic telephone service. It would have been obvious to modify

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Laor to include a step of canceling a pre-existing service to establish a new service, as is well known in the art.

Claim 6: Examine take Official Notice that the act of initiating a service contract as part of a purchase is very well known in the art. It would have been obvious to modify Laor to include the steps of initiating a service contract as part of a purchase made by a customer.

Claim 8: Switching service vendors is the same as canceling a service and starting a new service. See rationale as stated for claim 5.

Claims 9-11: Internet, telephone, television, banking or securities services are well known as offers to consumers. Modifying Laor for usage in offering any one of these services, or combinations of services, would have been obvious to one of ordinary skill in the art as a choice of design.

Claims 33-37: Examiner takes Official Notice that credit cards are very well known in the art for conducting electronic commerce and transmitting payment. It would have been obvious to modify the steps of Laor to include crediting a charge for a service to a credit card account or crediting multiple charges to a credit card account as is very well known in the art for facilitating payment.

Claim 40: See rationale pertaining to claims 33-37.

Claim 51: Providing the subsidies in a sequence or sequential order would have been obvious to one of ordinary skill in the art as a choice of design.

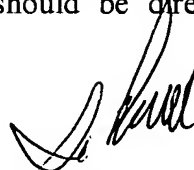
Claim 58: See rationale pertaining to claims 33-37.

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Claims 41-43, 52-53 and 55-56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 13-30 are allowed.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell  
Primary Examiner  
Art Unit 2166